

REMARKS

Claims 1, 2, and 5-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osypka (US 4,550,737). Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka when viewed in combination with Audoglio (US 6,556,874).

I. 35 U.S.C. § 102(b) Rejection

Claims 1, 2, and 5-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Osypka (US 4,550,737). Applicant respectfully traverses the grounds for this rejection.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Techs., Ltd. v. Rockwell Int’l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for “anticipation,” is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002).

Claim 1 has been amended to include, among other things, that “said overall circular contour further comprises an eccentric contour, relative to the first axis of the cylindrical body, that is centered on the second axis at the point where the variable radius is at a maximum.” As applicant’s undersigned attorney discussed with Examiner during their March 8, 2007 interview, this feature is not present in Osypka, or the secondary reference cited by the Examiner, and the Examiner agreed with this assessment. Indeed, although the radius of the threads may vary in the Osypka probe head, the contour is not “eccentric” and centered on an offset second axis at the point where the variable radius is at a maximum, as taught in amended independent claim 1. As stated above, without either an express or inherent disclosure of this claimed functionality

Osyпка cannot be anticipating prior art under 35 U.S.C. § 102. For this reason, the Applicant respectfully asks that the Examiner withdraw this rejection of claim 1, as amended, and dependent claims 5-11.

II. 35 U.S.C. § 103(a) Rejections

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka and claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Osypka when viewed in combination with Audoglio (US 6,556,874). Applicant respectfully traverses the grounds for this rejection in view of the above amendments to the claims and the following remarks.

To establish a *Prima Facie* case of obviousness, there must be: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings; (2) a reasonable expectation of success; and (3) prior art references which teach or suggest all of the claim limitations. *See In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); MPEP § 2143 (8th Ed., Rev. 1).

As discussed above, and during applicant's undersigned attorney's interview with the Examiner, Osypka does not disclose a circular contour that is eccentric and centered on an offset second axis at the point where the variable radius is at a maximum, as taught in amended independent claim 1. Moreover, Audoglio, when viewed either alone or in combination with Osypka, also fails to teach or suggest an "eccentric contour" as claimed in claim 1 of the present invention and thus does not cure the deficiencies of the primary reference. Indeed, the Examiner

apparently only relies on Audoglio for the disclosure of a helical retention element with a round profile (see Office Action at p. 7, ¶ 15).

Additionally, neither the Osypka nor Audoglio reference would motivate one to modify either reference to include the "eccentric contour" claimed in the present invention. Instead, both Osypka and Audoglio teach using a standard screw and thread design.

For the foregoing reasons, Applicant believes dependent claims 3, 4, and 12 are now in condition for allowance.


CONCLUSION

Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call applicant's undersigned attorney if doing so would expedite prosecution.

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Respectfully submitted,



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